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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Fabio CASATI et al. §	Confirmation No.: 4217
	§	
Serial No.:	09/911,916 §	Group Art Unit: 2124
	§	
Filed:	07/24/2001 §	Examiner: William H. Wood
	§	
For:	Modeling Tool For §	Docket No.: 10008278-1
	Electronic Services And §	
	Associated Methods §	
	And Businesses §	

APPEAL BRIEF

Mail Stop Appeal Brief – Patents   Date: August 8, 2005
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby submit this Appeal Brief in connection with the above-identified application. A Notice of Appeal was filed via facsimile on June 23, 2005.

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I.   REAL PARTY IN INTEREST

The real party in interest is the Hewlett-Packard Development Company, a Texas Limited Partnership, having its principal place of business in Houston, Texas. The Assignment from the inventors to Hewlett-Packard Company was recorded on February 1, 2002, at Reel/Frame 012572/0662. The Assignment of Assignors Interest from Hewlett-Packard Company to Hewlett-Packard Development Company L.P. was recorded on September 30, 2003, at Reel/Frame 014061/0492.

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II.   RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals or interferences.

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III.   **STATUS OF THE CLAIMS**

Originally filed claims: 1-32.

Claim cancellations: 13 and 32.

Added claims: None.

Presently pending claims: 1-12 and 14-31.

Presently appealed claims: 1-12 and 14-31.

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IV.   STATUS OF THE AMENDMENTS

No claims were amended after the final Office action dated May 18, 2005.

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V.   SUMMARY OF THE CLAIMED SUBJECT MATTER

The summary is set forth in the following exemplary embodiments that correspond to claims involved in the appeal. Discussions about elements and recitations of these claims can be found at least at the cited locations in the specification and drawings.

In accordance with various embodiments, as disclosed, for example in Appellants' disclosure on pages 8-9 describing Fig. 3, pages 18-19 describing Fig. 10, and pages 10-11 describing Figs. 10A and 10C, an electronic metaservice methodology comprises receiving a process definition, transforming the process definition into a composite process specification in a format supported by an electronic services platform, and registering the composite process specification with the electronic services platform. In the methodology, the composite process specification has a plurality of electronic services.

In accordance with another embodiment, a computerized system for creating composite electronic services for an electronic service platform is disclosed. Pages 10-11 and Figs. 10A and 10C. The computerized system comprises computer code for receiving a process definition, computer code for transforming the process definition into a composite process specification to be executed by at least one electronic services platform, and computer code for registering the composite process specification with said at least one electronic services platform. In this embodiment, the composite process specification has a plurality of electronic services.

In accordance with another embodiment, an electronic business system for an electronic services platform environment is disclosed. Pages 18-19 and Figure 10. The electronic business system comprises means for receiving a specification of a first electronic service and means for compiling other existing secondary electronic services into the first electronic service. The electronic business system also comprises means for structuring said first electronic service to be compatible with a given electronic services platform and means for registering said first electronic service in the electronic services platform environment.

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VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-12 and 14-31 are anticipated by Casati, et al., "eFlow: a Platform for Developing and Managing Composite e-Services."

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VII.   ARGUMENT

A.   Overview of the Casati Article

The Casati article describes a tool for defining a composite electronic service ("e-service") from basic electronic services. See page 341, Abstract. The Introduction of the Casati article explains that the article is directed to

> A platform ...that supports the specification, deployment, and management of composite e-services, i.e., of e-services that are carried out by invoking several other basic or composite services. [The platform] provides the service developer with a ... mechanism for defining services by composing basic ones. Composite services can be pre-defined or created on the fly. ... In addition, [the platform] supports the dynamic modification of service definitions while they are operational.

Page 341, Introduction.

The Casati article describes the capabilities of the platform to compose and manage e-services, both statically and dynamically. See pages 343-345, sections 3 and 4. The article also describes the "repository of processes, nodes, and data type definitions" that is included in the platform for use in specifying new composite services. Page 345, section 5. Although deployment of composite services is mentioned briefly in the Introduction of the article, nowhere in the article is any functionality for accomplishing such deployment discussed.

As is illustrated by the foregoing discussion, the Casati article pertains only to a tool that permits a user to create and modify composite services. The use of these composite services is beyond the scope of the article.

B.   Claims 1-3, 5-12

Appellants select claim 1 as representative of this group of claims. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

Claim 1 requires "registering the composite process specification with the electronic services platform." The Examiner identified page 347, left column, first

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paragraph of the Casati article as disclosing this limitation.   This paragraph states:

> Process templates can be divided into groups, and groups can be organized into a hierarchy in order to structure the repository and to simplify its browsing.   In addition, they have associated attributes (such as name, description, keywords, specialization/instantiation guidelines, etc) that help the service designer in querying the template repository and in using the selected template.

This paragraph is providing details regarding a repository that holds templates that might be used to create a composite process specification. (See Casati article, page 345, first paragraph of section 5.)   This paragraph says absolutely nothing about registering anything, much less registering a composite process specification with an electronic services platform.   Moreover, there is no mention of registration anywhere in the Casati article.

Claim 1 also requires receiving a process definition and "transforming the process definition into a composite process specification in a format supported by an electronic services platform, said composite process specification having a plurality of electronic services."   The Examiner identified pages 345-347, section 5 of the Casati article as allegedly teaching this limitation of claim 1.   This section of the Casati article describes "a repository of processes, nodes, and data type definitions." (Casati article, page 345, section 5, first paragraph.)   This repository is intended to be used by a service designer to define a composite service.   (See Casati article, page 345, section 5, first paragraph.)   Nowhere in this section, or anywhere else in the Casati article, is there any teaching or suggestion of transforming this definition into a composite process specification in a format supported by an electronic services platform.

The Examiner states that "Casati must transform the composite processes developed in section 5 on pages 345-347 in to something used be [sic] the electronic service.   Otherwise it would not be executable."   Final Office Action, page 8.   The Examiner's statement is essentially an assertion that the transformation of a process definition into a composite process specification in a format supported by an electronic services platform is inherent in the Casati

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article. The section of the Casati article cited by the Examiner merely describes a repository including such items process templates, service nodes, and data types that may be used by an service developer to define and maintain composite services. There is no mention of any transformation of composite processes into "something used be [sic] the electronic service."

The Examiner has provided no rationale or evidence that satisfies the criteria for inherent disclosure required in the case law and by MPEP 2112. "In relying upon the theory of inherency, *the examiner must provide a basis in fact and/or technical reasoning to reasonably support* the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy,* 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (italics added; underlining in original); MPEP 2112. Clearly, the mere statement of the Examiner's opinion that "Casati must transform the composite processes ... in to something used be [sic] the electronic service. Otherwise it would not be executable." provides no basis in fact or technical reasoning that supports the alleged inherency of this limitation.

Furthermore, as *Levy* makes clear, the allegedly inherent characteristic must necessarily flow from the teachings of the cited prior art. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." *In re Rijckaert,* 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversing the examiner's inherency rejection). A mere possibility or probability is simply not enough to support inherency. *In re Robertson,* 169 F.3d 743, 745 (Fed. Cir.1999). The Examiner's assertion that "Casati must transform the composite processes" so that they are executable is mere speculation on the part of the Examiner that such a transformation is required. The teachings of the Casati article are directed to creating and managing composite services, not transforming them to an executable format and executing them. While execution of these services may be desirable and one could speculate that the composite process specifications are in a format supported by an electronic services platform, the allegedly inherent characteristic of "transforming the process definition into a composite process specification in a

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format supported by an electronic services platform" does not necessarily flow from the teachings of the Casati article.

The Casati article provides no information regarding the format of the composite services created by the disclosed tool. It may be that there is no need to perform any special operation to make the composite services executable, as the Examiner seems to believe. It may also be that there are many other ways to execute a composite service created by this tool on an electronic services platform besides an allegedly inherent "transforming the process definition into a composite process specification in a format supported by an electronic services platform." The Examiner is unfairly reading more into the article than it fairly discloses.

Furthermore, the Casati article is not a proper anticipatory prior art reference as it does not enable the practice of the claimed invention. It is well-established that in addition to disclosing every claim limitation, an anticipatory prior art reference must enable the practice of the invention and describe it sufficiently to have placed it in the possession of a person of ordinary skill in the field of the invention. *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994). Otherwise, the reference cannot be used to anticipate the claimed invention. "The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." MPEP 2121.01 citing *Elan Pharm., Inc. v. Mayo Foundation for Medical and Education Research*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003).

Appellants' claimed invention includes "transforming the process definition into a composite process specification in a format supported by an electronic services platform" and "registering the composite process specification with the electronic services platform." The Casati article does not disclose the technical detail that one of ordinary skill in the art would need to know to implement the limitations quoted above. For example, the Casati article fails to disclose 1) a process for transforming a process definition into a composite process definition

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with a format compatible with an electronic services platform; 2) a process for registering the composite process specification for use with an electronic service platform; and/or 3) a run-time architecture and flow for executing the composite process specification. Accordingly, the Casati article is not enabling and cannot be used to reject the claims.

Based on the forgoing, Appellants respectfully submit that the rejections of the claims in this first grouping be reversed, and the claims set for issue.

C.   Claims 14-16, 18-22

Appellants select claim 14 as representative of this group of claims. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

> Claim 14 requires "computer code for registering the composite process specification with said at least one electronic services platform." For reasons similar to those explained above, the Casati article does not teach or suggest registering a composite process specification with an electronic services platform that may execute the composite process specification.

Claim 14 also requires "computer code for transforming the process definition into a composite process specification that is to be executed by at least one electronic services platform, said composite process specification having a plurality of electronic services. For reasons similar to those explained above, the Casati article does not teach or even suggest transforming the process definition into a composite process specification that is to be executed by an electronic services platform.

Furthermore, for the reasons similar to those explained above, the Casati article is not a proper anticipatory prior art reference as it does not enable the practice of the claimed invention.

Based on the forgoing, Appellants respectfully submit that the rejections of the claims in this second grouping be reversed, and the grouping set for issue.

D.   Claims 23-31

Appellants select claim 23 as representative of this group of claims. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

Claim 23 requires "means for registering said first electronic service in the electronic services platform environment." For reason similar to those explained above, the Casati article does not teach or even suggest registering an electronic service in an electronic services platform environment.

Claim 23 also requires "means for structuring said first electronic service to be compatible with a given said electronic services platform." For reasons similar to those explained above, the Casati article does not teach or even suggest structuring a service to be compatible with a given electronic services platform. Instead, the Casati article only describes a tool that may be used to define and manage a composite service.

The Examiner states that "the services are compatible with the electronic services platform, as this is necessary for deployment and execution." Final Office Action, page 9. The Examiner points to page 341, right column, first full paragraph as somehow supporting this statement. The relevant portion of the cited paragraph reads as follows:

> [W]e have developed a platform ... that supports the specification, deployment, and management of composite e-services, i.e., of e-services that are carried out by invoking several other basic or composite services. [The platform] provides the service developer with a ... mechanism for defining services by composing basic ones. Composite services can be pre-defined or created on the fly. ... In addition, [the platform] supports the dynamic modification of service definitions while they are operational.

The Examiner seems to believe that because this paragraph mentions deployment, that "means for structuring said first electronic service to be compatible with a given said electronic services platform" are necessarily

included in the platform. The Examiner's statement is essentially an assertion that this limitation is inherent in the Casati article.

The Examiner has provided no rationale or evidence that satisfies the criteria for inherent disclosure required as explained above. Clearly, the mere opinion of the Examiner that because the Casati article mentions deployment, "the services are compatible with the electronic services platform" does not provide a factual basis or technical rationale to support the alleged inherency of this limitation.

Furthermore, the Examiner's assertion that that "the services are compatible with the electronic services platform, as this is necessary for deployment and execution" is mere speculation on the part of the Examiner that such compatibility is required. The teachings of the Casati article are directed to creating and managing composite services, not deploying them. While deployment of these services may be desirable and one could speculate that the services may need to be structured to be compatible with an electronic services platform, the allegedly inherent characteristic of "means for structuring said first electronic service to be compatible with a given said electronic services platform" does not necessarily flow from the teachings of the Casati article.

Furthermore, for reasons similar to those explained above, the Casati article is not a proper anticipatory prior art reference as it does not enable the practice of the claimed invention.

Based on the forgoing, Appellants respectfully submit that the rejections of the claims in this third grouping be reversed, and the grouping set for issue.

E.   **Claims 4 and 17**

Claims 4 and 17 depend from independent claims 1 and 14, respectively. These claims are patentable at least for the reasons stated above with regard to claims 1 and 14.

The Examiner erred in rejecting claims 4 and 17 for an additional reason. Appellants select claim 4 as representative of this group of claims. This grouping is for purposes of this appeal only, and should not be construed to mean the patentability of any of the claims may be determined, in later actions before a

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court, based on the grouping. Rather, the presumption of 35 U.S.C. § 282 shall apply to each claim individually.

Claim 4 requires "associating each of said service nodes with a sequential set of method nodes, wherein each said set of method nodes includes invocations of inherent operations associated with said associated one of said electronic services." The Examiner identified pages 344-347, sections 4 and 5 of the Casati article as disclosing this limitation. Section 4 describes a "generic service node" that "support[s] dynamic process definitions for composite services." A generic service node is "not statically bound or limited to a specific set of services" and includes a "configuration parameter that can be set with a list of actual services either at process instantiation time ... or at run-time." (Page 344, section 4.1, first paragraph). Section 5 describes a repository including process templates, service nodes, and data types that may be used to define a composite service. (See pages 345-347.) These sections say absolutely nothing about anything resembling a method node, much less associating a sequential set of method nodes with a service node, wherein the "set of method nodes includes invocations of inherent operations" associated with an electronic service. Moreover, there is no mention of method nodes anywhere in the Casati article.

Based on the forgoing, Appellants respectfully submit that the rejections of the claims in this fourth grouping be reversed, and the grouping set for issue.

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VIII.   CONCLUSION

For the reasons stated above, Appellants respectfully submit that the Examiner erred in rejecting all pending claims. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for In documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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IX.   CLAIMS APPENDIX

1.   (Previously presented) An electronic metaservice methodology comprising:

      receiving a process definition;

      transforming the process definition into a composite process specification in a format supported by an electronic services platform, said composite process specification having a plurality of electronic services; and

      registering the composite process specification with the electronic services platform.

2.   (Previously presented) The methodology as set forth in claim 1, said transforming further comprising:

      determining which elements of the process definition constitute specific electronic services and designating said elements as linked service nodes of a continuous flow defining said composite process specification.

3.   (Original) The methodology as set forth in claim 2 wherein said designating comprises:

      configuring each of said service nodes with service invocation setup requirements for an associated one of said electronic services.

4.   (Original) The methodology as set forth in claim 3 wherein said configuring further comprises:

      associating each of said service nodes with a sequential set of method nodes, wherein each said set of method nodes includes invocations of inherent operations associated with said associated one of said electronic services.

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5.   (Original) The methodology as set forth in claim 1, said registering further comprising:

establishing a repository of defined composite electronic services.

6.   (Original) The methodology as set forth in claim 5, said transforming further comprising:

using said defined composite electronic services in said repository for configuring other composite electronic services.

7.   (Original) The methodology as set forth in claim 1 said receiving further comprising:

receiving said process definition as a process flow language for composing e-services.

8.   (Original) The methodology as set forth in claim 1 further comprising:

providing ancillary functions selected from a group including: changing the process, managing individual electronic service definitions, monitoring run-time executions, and obtaining analytical-statistical reports regarding said process.

9.   (Previously presented) The methodology as set forth in claim 1 further comprising:

allowing service providers to invoke a composite process defined by said composite process specification as an individual electronic service via said electronic services platform.

10.   (Original) The methodology as set forth in claim 1 in an internet environment.

11.   (Original) The methodology as set forth in claim 1 wherein said at least one electronic service is an electronic services platform.

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12.   (Original) The methodology as set forth in claim 1 wherein said at least one electronic service is an electronic service directory.

13.   (Canceled).

14.   (Previously presented) A computerized system for creating composite electronic services for an electronic service platform comprising:

computer code for receiving a process definition;

computer code for transforming the process definition into a composite process specification that is to be executed by at least one electronic services platform, said composite process specification having a plurality of electronic services; and

computer code for registering the composite process specification with said at least one electronic services platform.

15.   (Original) The system as set forth in claim 14, said computer code for transforming further comprising:

computer code for determining which elements of the composite process constitute specific electronic services, and

computer code for designating said elements as linked service nodes of a continuous flow defining said composite process.

16.   (Original) The system as set forth in claim 15 wherein said computer code for designating comprises:

computer code for configuring each of said service nodes with service invocation setup requirements for an associated one of said electronic services.

17.   (Original) The system as set forth in claim 16 wherein said computer code for configuring further comprises:

        computer code for associating each of said service nodes with a sequential set of method nodes, wherein each said set of method nodes includes invocations of inherent operations associated with said associated one of said electronic services.

18.   (Original) The system as set forth in claim 14, said computer code for registering further comprising:

        computer code for establishing a repository of defined composite electronic services with said electronic services platform.

19.   (Original) The system as set forth in claim 18, said computer code for transforming further comprising:

        computer code for using said defined composite electronic services in said repository for configuring other composite electronic services.

20.   (Original) The system as set forth in claim 14 wherein system designers of said composite electronic services are provided with a Composite Service Definition Language format specification and said computer code for receiving said process definition is pre-structured for said a Composite Service Definition Language format.

21.   (Original) The system as set forth in claim 14 further comprising:

        computer code for providing ancillary functions selected from a group including: changing the process, managing individual electronic service definitions, monitoring run-time executions, and obtaining analytical-statistical reports regarding said process.

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22.   (Original) The system as set forth in claim 14 further comprising:
          computer interface code for allowing service providers to invoke said composite process as an individual electronic service via said existing electronic services platform.

23.   (Previously presented) An electronic business system for an electronic services platform environment, the business comprising:
          means for receiving a specification of a first electronic service;
          means for compiling other existing secondary electronic services into the first electronic service;
          means for structuring said first electronic service to be compatible with a given electronic services platform; and
          means for registering said first electronic service in the electronic services platform environment.

24.   (Original) The system as set forth in claim 23 further comprising:
          means for defining said specification.

25.   (Original) The system as set forth in claim 23 further comprising:
          means for forming a repository of a plurality of electronic services of a type of said first electronic service.

26.   (Original) The system as set forth in claim 23 further comprising:
          means for providing a work flow representative of said first composite electronic service such that said work flow is compatible with said electronic services platform structure.

27.   (Original) The system as set forth in claim 26 further comprising:
          means for providing an interaction gateway between said means for providing a work flow and said electronic services platform.

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28.   (Original) The system as set forth in claim 23 further comprising:
       means for monitoring said first electronic service.

29.   (Original) The system as set forth in claim 23 further comprising:
       means for maintaining said first electronic service.

30.   (Original) The system as set forth in claim 29, said means for maintaining
further comprising:
       means for updating said first electronic service after registration with said
              electronic services platform.

31.   (Original) The system as set forth in claim 29, said means for maintaining
further comprising:
       means for deleting said first electronic service from registration with said
              electronic services platform.

32.   (Canceled).

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X.   EVIDENCE APPENDIX

None.

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XI.   RELATED PROCEEDINGS APPENDIX

None.